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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,690	03/29/2004	J. Christopher Marmo	D-4109	1370
61535 7590 03/14/2007 FRANK J. UXA STOUT, UXA, BUYAN & MULLINS, LLP			EXAMINER	
			NUTTER, NATHAN M	
4 VENTURE, SUITE 300 IRVINE, CA 92618			ART UNIT	PAPER NUMBER
			1711	
SHORTENED STATUTORY	PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE	
3 MONTHS 03/14/2007		PAPER		

# Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
	10/811,690	MARMO, J. CHRISTOPHER
Office Action Summary	Examiner	Art Unit
	Nathan M. Nutter	1711 .
The MAILING DATE of this communication a Period for Reply	ppears on the cover sheet wit	h the correspondence address
A SHORTENED STATUTORY PERIOD FOR REF WHICHEVER IS LONGER, FROM THE MAILING  - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period for reply within the set or extended period for reply will, by state Any reply received by the Office later than three months after the main earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNIC 1.136(a). In no event, however, may a re od will apply and will expire SIX (6) MONT tute, cause the application to become ABA	ATION.  ply be timely filed  THS from the mailing date of this communication.  ANDONED (35 U.S.C. § 133).
Status .		
1) Responsive to communication(s) filed on <u>02</u>	February 2007.	
<del>'=</del>	nis action is non-final.	
3) Since this application is in condition for allow	•	·
closed in accordance with the practice unde	r Ex parte Quayle, 1935 C.D.	11, 453 O.G. 213.
Disposition of Claims		
4)  Claim(s) 114-171 is/are pending in the application 4a) Of the above claim(s) 127-171 is/are with 5)  Claim(s) is/are allowed.  6)  Claim(s) 114-126 is/are rejected.  7)  Claim(s) is/are objected to.  8)  Claim(s) are subject to restriction and	ndrawn from consideration.	
Application Papers		·
9) The specification is objected to by the Exami 10) The drawing(s) filed on is/are: a) a Applicant may not request that any objection to the Replacement drawing sheet(s) including the correction.  11) The oath or declaration is objected to by the	ccepted or b) objected to be ne drawing(s) be held in abeyand ection is required if the drawing(s	ce. See 37 CFR 1.85(a). s) is objected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority docume 2. Certified copies of the priority docume 3. Copies of the certified copies of the prapplication from the International Bure * See the attached detailed Office action for a li	ents have been received. ents have been received in Apriority documents have been reau (PCT Rule 17.2(a)).	oplication No received in this National Stage
Attachment(s)		
Notice of References Cited (PTO-892)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  Information Disclosure Statement(s) (PTO/SB/08)  Paper No(s)/Mail Date	Paper No(s)	ummary (PTO-413) /Mail Date formal Patent Application 

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### **DETAILED ACTION**

#### Election/Restrictions

Newly submitted claims 127-171 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

- 1) claims 127-141 recite "a seal surrounding the cavity to maintain the contact lens in a sterile environment," which was not within the scope of the claims as originally examined,
- 2) claims 142-156 recite "a seal surrounding the cavity to maintain the contact lens in a sterile environment," which was not within the scope of the claims as originally examined, and
- 3) claims 157-171 recite "a reaction product of a polymerizable composition," which is of a different scope than the originally claimed mixture of resins.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 127-171 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 114-126 remain pending for prosecution.

## Response to Amendment

In response to the amendment filed 2 February 2007, the following is placed in effect.

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The rejection of claims 4, 7, 10, 19, 22, 24 and 27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is hereby expressly withdrawn.

The rejection of claims 4, 7, 10, 16, 19, 22, 24, 27, 32, 34-36, 38, 40 and 42-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The rejection of claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 under 35 U.S.C. 102(b) as being anticipated by Hu et al (US 2001/0044482), is hereby expressly withdrawn.

The rejection of claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 under 35 U.S.C. 102(b) as being anticipated by Gordon (US 4,123,408), is hereby expressly withdrawn.

The rejection of claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 under 35 U.S.C. 102(b) as being anticipated by Shah (US 4,462,665), is hereby expressly withdrawn.

The rejection of claims1-3, 10, 16-19 and 27 under 35 U.S.C. 102(b) as being anticipated by Tanaka et al (US 6,008,170), is hereby expressly withdrawn.

The rejection of claims 1-3, 10, 16-19 and 27 under 35 U.S.C. 102(b) as being anticipated by Salpekar et al (US 6,440,366), is hereby expressly withdrawn.

The following new grounds of rejection are being made.

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#### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

Claims 114-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al (US 2001/0044482), Gordon (US 4,123,408), or Shah (US 4,462,665), all previously cited, each taken in view of Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) and Park et al (US 5,882,678), all newly cited.

The reference to Hu et al (US 2001/0044482) shows the contemplated contact lens employed in the instant claims at the Abstract, paragraphs [0017]-[0019], [0022], [0029], [0032]-[0035], [0047]-[0048], [0051] and the many Examples.

The reference to Gordon (US 4,123,408) shows the contemplated contact lens employed in the instant claims at the Abstract, column 2 (lines 38-55), column 3 (line 64) to column 6 (line 63), the Example at columns 8 and 9 and the claims.

The reference to Shah (US 4,462,665) shows the contemplated contact lens employed in the instant claims at the Abstract, column 2 (line 1) to column 4 (line 49), the many Examples and the claims.

Each of the references to Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) and Park et al (US 5,882,678) show the storage

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and cleaning of contact lenses using polymers, as herein recited and claimed. Note in Dziabo et al at the paragraph bridging column 5 to column 6) for the use of polymers derived from vinyl ethers (claim 122), polyacrylates and polyacrylic acids (claims 123 and 124), polyvinyl pyrrolidone (lactam) (claim 125), and polyvinyl alcohol (claim 126). The reference to Park et al shows the storage of contact lenses in the disinfectant/cleaning compositions and teaches specifically polyacrylates (claim 123), polyacrylic acid (claim 124) and polymethacrylic acid (claim 126) in a package system, as recited herein. Note column 2 (lines 35-63). The reference to Huth et al shows the use of PVP (claim 125) for "contact lends care," such as storage. Note the Abstract. The patent to Krezanoski et al shows the use of vinyl ethers for storage and cleaning of contact lenses. Note the Abstract.

The primary references teach the contact lens of the claims. The secondary references show the solutions for cleaning/storage and show such as conventional, as recited herein. The employment of a package is notoriously obvious since the product must be vended and distributed. As such, a skilled artisan would have a high level of expectation of success following the teachings of the references. Nothing unexpected is shown on the record.

Claims 114-116 and 122-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 6,008,170) or Salpekar et al (US 6,440,366), each taken in view of Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) or Park et al (US 5,882,678).

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The reference to Tanaka et al (US 6,008,170) shows the contemplated contact lens employed in the instant claims at the Abstract, the paragraph bridging column 3 to column 4, column 6 (lines 45-61), the Examples and claims.

The reference to Salpekar et al (US 6,440,366) shows the contemplated contact lens employed in the instant claims at the Abstract, column 3 (line 53) to column 7 (line 57), the Examples and the claims.

Each of the references to Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) and Park et al (US 5,882,678) show the storage and cleaning of contact lenses using polymers, as herein recited and claimed. Note in Dziabo et al at the paragraph bridging column 5 to column 6) for the use of polymers derived from vinyl ethers (claim 122), polyacrylates and polyacrylic acids (claims 123 and 124), polyvinyl pyrrolidone (lactam) (claim 125), and polyvinyl alcohol (claim 126). The reference to Park et al shows the storage of contact lenses in the disinfectant/cleaning compositions and teaches specifically polyacrylates (claim 123), polyacrylic acid (claim 124) and polymethacrylic acid (claim 126) in a package system, as recited herein. Note column 2 (lines 35-63). The reference to Huth et al shows the use of PVP (claim 125) for "contact lends care," such as storage. Note the Abstract. The patent to Krezanoski et al shows the use of vinyl ethers for storage and cleaning of contact lenses. Note the Abstract.

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#### Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Due to the new grounds of rejection, this action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1009.

Nathan M. Nutter Primary Examiner Art Unit 1711

nmn

13 March 2007